

**1. Rejection of Claims 1-9 Under 35 U.S.C. §102(e)/103(a)**

The Office Action states claims 1-9 are rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 7,019,089 (herein referred to as "Schneider, et al."). In particular, the Office Action states,

Schneider discloses a process for preparing supported, titanized chromium catalysts, which comprises the following steps: A) brining a spherical, spray-dried, oxidic support material into contact with a titanium compound in a suspension, B) brining the support material which has been treated into contact with a chromium salt solution in a suspension and subsequently removing the solvent, C) optionally, calcining the precatalyst obtained in step B), etc., and D) activating the precatalyst obtained in step B) or C) at a temperature of from 500°C to 800°C in an oxygen-containing atmosphere (see col. 14, claim 1). Methanol (or a protic medium) is used as a solvent to prepare the chromium mixture (see col. 10, Example 1). The oxidic support is silica gel (see col. 14, claim 2). Schneider also discloses a process for preparing homopolymers of ethylene and copolymers of ethylene, etc. using supported titanized chromium catalysts prepared by a process as described above (see col. 14, claim 7).

While Schneider is silent with respect to the water content contained in the protic medium, it is inherent that the same protic medium used would contain the same water content as being claimed.

In the alternative, if in fact the water content in the protic medium of the Schneider's process is not the same as the claimed water content then the following applies.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have controlled the water content in the protic medium in Schneider's process in order to result in an effective catalyst because of In re Boesch.

**RESPONSE**

Applicant respectfully traverses the rejection of claims 1-9.

First and foremost, Applicant respectfully notes U.S. Patent 7,019,089 (also referred to herein as "Schneider, et al."), which is being relied upon for the current 35 U.S.C. 102(e)/103(a) rejection, entered the national phase from International Application PCT/EP01/07410, filed June 28, 2001, and was published as WO 02/02652. A copy of WO 02/02652 is enclosed herewith as ATTACHMENT A.

Additionally, Applicant respectfully notes 35 U.S.C. §102(e) recites,

A person shall be entitled to a patent unless -

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(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, **except that an international application filed under the treaty defined in section 351(a)** shall have the effects for the purposes of this subsection of an application filed in the United States **only if** the international application **designated the United States and was published** under Article 21(2) of such treaty **in the English language**; (Emphasis added)

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As such, for a U.S. Patent stemming from the national stage of an International Application filed on or after November 29, 2000 to have a 35 U.S.C. §102(e) date, the International Application **must**

designate the United States, **and** the International Application **must be published in English.**

However, Applicant respectfully notes the U.S. Patent 7,019,089 to Schneider, et al. entered the national phase from International Application PCT/EP01/07410, which **was published in German** as WO 02/02652. Accordingly, Applicant respectfully believes U.S. Patent 7,019,089, as well as WO 02/02652, **both do not have a 35 U.S.C. §102(e) date.** See MPEP §706.02(f)(1), Example 5. Therefore, Applicant respectfully believes any rejection under 35 U.S.C. §102(e) is erroneous and improper, regardless if U.S. Patent 7,019,089 is being applied under 35 U.S.C. §102(e) for an anticipation rejection, or being brought in under 35 U.S.C. §102(e) for an obviousness rejection under 35 U.S.C. §103(a).

Consequently, since the current rejection is legally insufficient, for this reason alone, Applicant respectfully believes the current rejection should be withdrawn.

Notwithstanding, as previously outlined in Applicant's previous responses of August 7, 2006 and April 17, 2007, for a reference to anticipate an invention, **all** of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether **each and every element** as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), (Emphasis added). The **identical**

invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (Emphasis added). The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Additionally, as previously outlined in Applicant's aforementioned responses, Applicant respectfully believes Schneider, et al. fails to disclose, teach, or suggest, "A process for preparing supported, titanized chromium catalysts, which comprises the following steps:

A) bringing a support material into contact with a protic medium having a water content less than 20% by weight and comprising a titanium compound and a chromium compound;

B) optionally, removing the protic medium, thereby forming a precatalyst;

C) optionally, calcining the precatalyst obtained after step B); and

D) optionally, activating the precatalyst obtained after step B) or C) in an oxygen-containing atmosphere at from 400°C to 1100°C."

In particular, Applicant believes Schneider, et al. fails to disclose, teach, or suggest a process for preparing supported, titanized chromium catalysts in which the support material is brought into contact with a protic medium comprising both a titanium and chromium compound **in a single step**. In fact, as conceded in

several Office Actions by the Examiner (i.e., see page 3, paragraph 4, lines 4-8 of the current Office Action), Schneider, et al. discloses a **two-step** process for preparing supported, titanized chromium catalysts which comprises I) bringing an oxidic support material into contact with a titanium compound, and then II) bringing the titanium-treated support material into contact with a chromium salt solution. See col. 2, lines 12-19, and col. 4, line 46 - col. 5, line 7 in Schneider, et al.

Accordingly, Applicant respectfully contends since the Examiner clearly concedes Schneider, et al. discloses a **two-step** process for preparing titanized chromium catalysts, and not a **one-step** process as currently claimed, Schneider, et al. clearly cannot anticipate the currently pending claims under 35 U.S.C. §102. The **identical** invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (Emphasis added).

Additionally, the Examiner concedes Schneider, et al. does not disclose, teach, or suggest the currently claimed water content of the protic medium. See page 3, paragraph 4, lines 15-19.

As a way to account for this difference, the Examiner has made a broad-brush assertion that the currently claimed water content of the protic medium would be inherent in Schneider, et al. However, the Examiner has not proffered any *factual, objective evidence* or *any reasonable technical rationale* to support such a claim of inherency. "To establish inherency, the extrinsic evidence 'must

make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), (Emphasis added). Additionally, see MPEP §2112 (IV) and §2163.07(a).

As such, for the reasons set forth above, Applicant respectfully believes *Schneider, et al.* does not anticipate the currently pending claims. Accordingly, Applicant respectfully requests the Examiner to withdraw the currently pending anticipation rejection.

With respect to the currently pending obviousness rejection, as previously outlined in Applicant's response of August 7, 2006, the currently claimed subject matter, and the subject matter contained in *Schneider, et al.*, are commonly owned, and Applicant was subject to an obligation of assignment to the owner of the *Schneider, et al.* patent at the time the claimed subject matter was made. Applicant previously submitted as ATTACHMENT B on August 7, 2006, (1) a copy of the Recordation of Assignment for the currently pending application, and (2) a copy of the assignee of record for the *Schneider, et al.* patent.

Accordingly, even if U.S. Patent 7,019,089 had a 35 U.S.C. §102(e) date, which as outlined *supra* it clearly does not, Applicant respectfully believes U.S. Patent 7,019,089 still would not be

considered prior art under 35 U.S.C. 103(a) in light of 35 U.S.C. §103(c). See MPEP §2146.

Moreover, Applicant responds as follows with respect to the Examiner's comments on page 4 of the currently pending Office Action, which states,

Further, the examiner maintains the position concluding that the claimed process step (or so-called a single-step process) of bringing a support material into contact with a protic medium comprising a titanium compound and a chromium compound is not distinguished from the disclosed process step (or a two-step-process) taught by Schneider et al. because the reference does not include any heat treatment step, such a drying or calcining between the process of adding the titanium compound and the chromium compound together for form a catalyst mixture. See Examples of Schneider et al. Thus, the final catalyst mixture (or precursor) of Schneider et al. would be the same, in terms of composition, as the claimed catalyst mixture. Unless, there is criticality shown or comparative data provided showing the addition of the titanium compound and the chromium separately would not result in the same catalyst composition, otherwise.

However, as acknowledged by the Examiner, Schneider, et al. clearly discloses a different process than the process currently claimed by Applicant (i.e., as acknowledged by the Examiner, Schneider, et al. discloses a two-step process, whereas Applicant is currently claiming a one-step process). Accordingly, given this difference, the process of Schneider, et al. clearly cannot anticipate Applicant's currently claimed process, **regardless of the product produced**. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Additionally, since the instant application and U.S. Patent 7,019,089 are commonly owned, and the instant application was subjected to assignment to the owner of U.S. Patent 7,019,089, even if U.S. Patent 7,019,089 had a 35 U.S.C. §102(e) date, which clearly it does not, any rejection to U.S. Patent 7,019,089 under 35 U.S.C. §103(a) based on 35 U.S.C. §102(e) would be obviated by 35 U.S.C. §103(c).

As such, it is clearly improper for the Examiner to maintain Applicant's currently claim process claims 1-6 and 8-9 are anticipated by, or alternatively are unpatentable over U.S. Patent 7,019,089 to Schneider, et al.

Furthermore, Applicant respectfully responds as follows with respect to the Examiner's contention,

Unless, there is criticality shown or comparative data provided showing the addition of the titanium compound and the chromium separately would not result in the same catalyst composition, otherwise.

However, it is incumbent on the Examiner to **first** establish a *prima facie* case of obviousness **before** Applicant is required to demonstrate criticality or unexpected results. Gillette Co. v. S.C. Johnson & Son, Inc., 12 U.S.P.Q.2d (BNA) 1929 (D. Mass. July 31, 1989). Additionally, see MPEP §2141 and §2142. Accordingly, since the Examiner has not established a *prima facie* case of obviousness with respect to Applicant's currently pending claim 7, nor has the Examiner demonstrated Applicant's currently pending claim 7 is anticipated, Applicant respectfully believes the current rejection



should be withdrawn without the need of any additional showing from Applicant.

In light of the above, claims 1-9 are therefore believed to be novel and patentably distinguishable from Schneider, et al. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

### CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the references of record. The Examiner is therefore respectfully requested to reconsider and withdraw all rejections and allow all pending claims 1-9. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned practitioner if she has any questions or comments.

Respectfully submitted,

By: 

Jarrod N. Raphael  
Registration No. 55,566  
Customer No. 34872

Date: February 29, 2008  
Basell USA Inc.  
Delaware Corporate Center II  
2 Righter Parkway, Suite 300  
Wilmington, Delaware 19803  
Telephone No.: 302-683-8176  
Fax No.: 302-731-6408